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Joseph S Tripoli
Patent Operations
Thomson Multimedia Licensing Inc
P O Box 5312
Princeton, NJ 08543-5312

EXAMINER	
SCHNURR, JOHN R	

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/980,355
Filing Date: July 25, 2002
Appellant(s): BASSET, JEAN-CLAUDE

Paul P. Kiel
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/23/2009 appealing from the Office action mailed 07/06/2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

NEW GROUND(S) OF REJECTION

Claims 17-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,163,316	Killian	12-2000
6,177,931	Alexander et al.	1-2001
6,571,392	Zigmond et al.	5-2003
6,665,869	Ellis et al.	12-2003
2005/0166257	Feinleib et al.	7-2005

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims **17-19** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 17-19 are drawn to functional descriptive material recorded on a computer readable-medium. Normally, the claim would be statutory. However, the specification does not limit the claimed readable medium to non-transitory media and thus the broadest reasonable interpretation of the claims includes transitory media such as signals.

A “signal” embodying functional descriptive material is neither a process nor a product (i.e., a tangible “thing”) and therefore does not fall within one of the four

statutory classes of § 101. Rather, "signal" is a form of energy, in the absence of any physical structure or tangible material.

Because the full scope of the claim as properly read in light of the disclosure encompasses non-statutory subject matter, the claim as a whole is non-statutory.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim **19** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim includes the limitation of a computer readable medium being distributed by downloading. This limitation is indefinite because a medium cannot be downloaded. The signal embodying the software product may be downloaded to a user device, however the medium bearing the signal cannot.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims **1-10, 12, 13 and 16-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Killian (US Patent 6,163,316)** in view of **Alexander et al. (US Patent 6,177,931)**, herein Alexander, and further in view of **Zigmond et al. (US Patent 6,571,392)**, herein Zigmond.

Consider **claim 1**, Killian clearly teaches digital-television receiver/decoder device of the type comprising:

> an input interface receiving digital-television signals originating from a predetermined broadcast network and for delivering a digital stream of television signals; **(column 3 lines 50-58 and column 4 lines 20-23)**
>
> a demultiplexer/extractor module suitable for extracting, from the digital stream, digital sequences relating to a chosen television program; **(Fig. 1: Tuner/decoder 24 receives the broadcast signal and outputs an audio/video signal to television 40, column 4 lines 20-38, therefore the system must have a demultiplexer.)**
>
> a decoder module converting the digital sequences thus extracted into television signals compatible with a visual-display module; **(Fig. 1: Tuner/decoder 24, column 4 lines 20-38)**
>
> a module for recording and playing digital sequences of digital-television programs; **(Fig. 1: Recorder 20)**
>
> a processing module receiving, from a software application received from another medium, **(Fig. 3: EPG 70 is obtained form the Internet over link 14, column 8 lines 36-56.)** initialization and marking information from said other medium, relating at least to the start and to the end of a television program, as well as to the reception/extraction of the digital sequences relating to said television program, causing the recording of the digital sequences relating to said television program as well as the initialization and marking information, in the record/replay module; **(EPG 70 contains information related to the airing of the program to be recorded, including start and end times, and instructs the recorder 20 to record the program, column 17 line 43 to column 18 line 2.)**

However, Killian does not explicitly teach comparing said initialization and marking information with the television digital stream originating from the demultiplexer/extractor module, said processing module in response to a positive comparison, for causing the recording of the digital sequences relating to said chosen television program in the record/replay module.

In an analogous art, Alexander, which discloses a system for recording broadcast content, clearly teaches comparing said initialization and marking information with the television digital stream originating from the demultiplexer/extractor module, said processing module in response to a positive comparison, for

causing the recording of the digital sequences relating to said chosen television program in the record/replay module. **(column 11 lines 9-28; column 11 line 64 to column 12 line 9; column 12 lines 30-43)**

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of Killian by comparing the actual broadcast data with the initialization and marking information to determine when to begin and end recording, as taught by Alexander, for the benefit of preventing the wrong program from being recorded (column 11 lines 9-28 Alexander).

However, Killian combined with Alexander does not explicitly teach an execution module, at the request of a user, for launching the playing of the digital sequences relating to said television program thus recorded, in synchronism with the initialization and marking information, wherein said execution module further comprises a supplementary processing module for running software application further containing said initialization and marking information, the software application being run in synchronism and in interactive mode with the playing of the digital-television program thus recorded with the aid of said initialization and marking information.

In an analogous art, Zigmond, which discloses a system for recording broadcast content, clearly teaches an execution module, at the request of a user, for launching the playing of the digital sequences relating to said television program thus recorded, in synchronism with the initialization and marking information, wherein said execution module further comprises a supplementary processing module for running software application further containing said initialization and marking information, the software application being run in synchronism and in interactive mode with the playing of the digital-television program thus recorded with the aid of said initialization and marking information. **(The system plays back recorded video and interactive data in synchronization, column 9 line 54 to column 10 line 10.)**

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of Killian combined with Alexander by recording interactive data along with the video and playing back the video and interactive data in synchronization, as taught by Zigmond, for the benefit of viewing time shifted interactive content (column 4 lines 17-40 Zigmond).

Consider **claim 2**, Killian combined with Alexander and Zigmond, as in claim 1, clearly teaches the supplementary processing module consists of Internet processing means, intended to provide a link according to an Internet protocol IP, cooperating with memory-storage to store an Internet browser serving for Internet

browsing, and in that the receiver/decoder device further comprises a communications module communicating with a remote server according to the Internet protocol. **(column 6 line 60 to column 7 line 7 Zigmond)**

Consider **claim 3**, Killian combined with Alexander and Zigmond, as in claim 1, clearly teaches the communications module downloads the software application originating from the remote server. **(column 8 lines 1-6 Zigmond)**

Consider **claim 4**, Killian combined with Alexander and Zigmond, as in claim 1, clearly teaches a media player able to read a data medium containing the software application. **(column 7 lines 25-28 Killian)**

Consider **claim 5**, Killian combined with Alexander and Zigmond, as in claim 1, clearly teaches means suitable for receiving the software application with the digital-television stream. **(column 5 lines 34-46 Zigmond)**

Consider **claim 6**, Killian combined with Alexander and Zigmond, as in claim 1, clearly teaches the execution module launches the playing of the digital sequences relating to the chosen television program and the running of the software application on the same visual-display module. **(Fig. 2: Display 202 shows video and additional information being displayed together, column 4 line 64 to column 5 line 3 Zigmond.)**

Consider **claim 7**, Killian combined with Alexander and Zigmond, as in claim 1, clearly teaches man/machine interface means, the actuation of which allows the user to interact simultaneously and in synchronism in the playing of the recorded television program and in the running of the predetermined software application. **(column 7 lines 47-54 Zigmond)**

Consider **claim 8**, Killian combined with Alexander and Zigmond, as in claim 1, clearly teaches the Internet processing means cooperates with the visual-display module as well as a man/machine interface means of the receiver/decoder device. **(Fig. 2: Display 202 shows video and additional information being displayed together, column 4 line 64 to column 5 line 3 Zigmond. Man/machine interface, column 7 lines 47-54 Zigmond.)**

Consider **claim 9**, Killian combined with Alexander and Zigmond, as in claim 1, clearly teaches the demultiplexer/extractor module extracts the initialization and marking information of the television program **(Fig. 1 VBI decoder 28, column 4 lines 29-35 Killian)** and sends the information to the Internet processing means to allow running of the predetermined software application in local mode and/or in cooperation with the remote server, in synchronism with the playing of the recorded television program. **(column 6 line 25 to column 7 line 7 Zigmond)**

Consider **claim 10**, Killian combined with Alexander and Zigmond, as in claim 1, clearly teaches the Internet processing means, in cooperation with the processing means of the receiver/decoder, drives the record/replay module. **(column 7 lines 8-35 Zigmond)**

Consider **claim 12**, Killian combined with Alexander and Zigmond, as in claim 1, clearly teaches an image-composition module suitable for receiving the video images output by the decoder module as well as a graphics images output by an Internet processing means, so as to combine them according to a chosen image-composition mode. **(Fig. 2: Display 202 shows video and additional information being displayed together, column 4 line 64 to column 5 line 3 Zigmond.)**

Consider **claim 13**, Killian combined with Alexander and Zigmond, as in claim 1, clearly teaches the image- composition mode is of overprint, multi-windowing, text, image-combining type. **(Fig. 2: Display 202 Zigmond)**

Consider **claim 16**, see claim 1.

Consider **claim 17**, Killian clearly teaches a microprocessor executing instruction stored on a memory **(column 3 lines 7-18)** to accomplish the process of claim 1, see the rejection of claim 1.

Consider **claim 18**, Killian combined with Alexander and Zigmond, as in claim 1, clearly teaches the software application is capable of being run on-line with a remote server. **(Killian teaches communications with a remote server, column 8 lines 36-56.)**

Consider **claim 19**, Killian combined with Alexander and Zigmond, as in claim 1, clearly teaches the computer readable medium is at least one of: a data medium, program memory, and distributed by downloading. **(column 3 lines 7-18 Killian)**

7. Claim **11** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Killian (US Patent 6,163,316)** in view of **Alexander et al. (US Patent 6,177,931)**, herein Alexander, and further in view of **Zigmond et al. (US Patent 6,571,392)**, as applied to claim 1 above, and further in view of **Ellis et al. (US Patent 6,665,869)**, herein Ellis.

Consider **claim 11**, Killian combined with Alexander and Zigmond, as in claim 1, clearly teaches Internet processing means.

However, Killian combined with Alexander and Zigmond does not explicitly teach the Internet processing means delivers, to the record/replay module, commands of the stop, pause, pause start, start, slow, fast forward, rewind, jump forward, jump back, type.

In an analogous art, Ellis, which discloses a system for receiving digital video, clearly teaches a set-top box (processing means) that controls recording and other features of a program using an infrared transmitter and receiver. The commands are given through a remote control, keyboard, mouse, touch-pad and other various devices **(Fig. 1: 34; Fig. 2: 30a, 30b, 30c, column 4 lines 46-51, column 4 line 66 to column 5 line 12 and column 5 lines 25-29)**.

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of Killian combined with Alexander and Zigmond by including a controlling device used to deliver commands to the recording device, as taught by Ellis, for the benefit of controlling a set-top box, a videocassette recorder and a television (see column 4 lines 51-53 of Ellis).

8. Claims **14 and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Killian (US Patent 6,163,316)** in view of **Alexander et al. (US Patent 6,177,931)**, herein Alexander, and further in view of **Zigmond et al. (US Patent 6,571,392)**, as applied to claim 1 above, and further in view of **Feinleib et al. (US Patent Application Publication 2005/0166257)**, herein Feinleib.

Consider **claim 14**, Killian combined with Alexander and Zigmond, as in claim 1, clearly teaches combining broadcast content and Internet content on a display.

However, Killian combined with Alexander and Zigmond, as in claim 1, does not explicitly teach:

a first memory containing the video images output by the decoder module;

a second memory containing the graphics information output by the Internet processing means;

a third memory containing an image-composition program;

image-processing means extracting the chosen information from the first and second memories depending on the composition program, so as to produce the composite images;

a module for synchronization of the visual-display module, to synchronize the composition of images output by the two memories.

In an analogous art, Feinleib, which discloses a system for synchronizing video content and interactive data, clearly teaches:

a first memory containing the video images output by the decoder module; **(Fig. 1: Storage device 16 Pierre)**
a second memory containing the graphics information output by the Internet processing means;
a third memory containing an image-composition program; **(Fig. 2: Program memory 56 is suitable for storing graphics information and an image-composition program Feinleib.)**

image-processing means extracting the chosen information from the first and second memories depending on the composition program, to produce the composite images; **([0013]-[0014] Feinleib)**

a module for synchronization of the visual-display module, to synchronize the composition of images output by the two memories. **([0077]-[0088] Feinleib)**

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of Killian combined with Alexander and Zigmond by combining video and images, as taught by Feinleib, for the benefit of providing additional information with the video stream.

Consider **claim 15**, Killian combined with Alexander and Zigmond, as in claim 1, clearly teaches a digital television receiver/decoder device.

However, Killian combined with Alexander and Zigmond, as in claim 1, does not explicitly teach an interface of serial type and/or an interface of high-throughput link type so as to connect peripheral equipment of the printer, video camera system, audio suite or video peripheral type

In an analogous art, Feinleib, which discloses a system for synchronizing video content and interactive data, clearly teaches an interface of serial type and/or an interface of high-throughput link type so as to connect peripheral equipment of the printer, video camera system, audio suite or video peripheral type **(Fig. 2: Input devices 58, Display 60 and Stereo I/O 62)**

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of Killian combined with Alexander and Zigmond by including an interface of serial type and/or an interface of high-throughput link type so as to connect peripheral equipment of the printer, video camera system, audio suite or video peripheral type, as taught by Feinleib, for the benefit of increasing the functionality of the device.

(10) Response to Argument

In response to appellant's arguments (Appeal Brief Section 7A) that the combination of Killian, Alexander and Zigmond does not disclose "a processing module receiving, from a software application received from another medium, initialization and marking information from said other medium, relating at least to the start and to the end of a television program," the examiner respectfully disagrees.

Killian clearly shows an electronic program guide (EPG) 70 is downloaded from an Internet link 14 (col. 8 lines 36-40). The EPG contains information defining the start and end of television programs (col. 8 lines 53-56). The EPG is clearly a software application received from another medium which contains start and stop information for a television program.

Appellant argues that schedule 100 is the initialization and marking information and since the schedule 100 is not received from another medium it does not meet the claim limitations. This argument is clearly erroneous as the schedule 100 was never suggested as meeting the initialization and marking information limitation as well as the fact that the EPG meets each limitation for such information.

Appellant further argues that the EPG 70 does not contain all the information necessary to select, schedule and record viewing opportunities. The downloaded EPG

70 contains a control module 72, profile module 74, suggest module 76 and schedule module 78 that cooperate to provide EPG functionalities. The program listing data is downloaded using link 14. (col. 8 lines 36-56) These modules are clearly adequate to enable selection, scheduling and recording of programs. Furthermore, Killian explicitly states this in the portion of the reference cited by the appellant.

Appellant further argues Killian does not disclose comparing EPG information and causing a recording if the comparison is positive. It is noted that the claim language does not state with what the initialization and marking information is being compared. Furthermore, EPG 70 is program based and allows for a program identifier to be selected which is then compared to the broadcast information, start/stop time, and a program is recorded when the comparison shows the selected program is airing (col. 17 lines 7-26).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/John R Schnurr/

Examiner, Art Unit 2421

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Timothy P Callahan/

Director, Technology Center 2400

Conferees:

/John W. Miller/

Supervisory Patent Examiner, Art Unit 2421

/Christopher Kelley/

Supervisory Patent Examiner, Art Unit 2424